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In re Application of :
Uber, et al. :
Application No. 09/545,582 : PETITION
Filed: April 7, 2000 :
Attorney Docket No.: VI/96-068.RE.C :
For: PATIENT INFUSION SYSTEM FOR :
USE WITH MRI :
:

OFFICE OF PETITIONS

This is a decision on the petition filed November 2, 2001 under 37 CFR 1.137(b). As the instant petition also attributes the delay in responding to the non-final Office action to unavoidable delay, the petition is also being treated under 37 CFR 1.137(a). This is also a decision on the petition for extension of time pursuant to 37 CFR 1.136(a) and alternatively 37 CFR 1.136(b) filed May 21, 2001.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

The petition under 37 CFR 1.137(b) is **GRANTED**.

The petition under 37 CFR 1.136 is **DISMISSED**.

This application became abandoned April 22, 2001 for failure to timely file a proper response to the non-final Office action mailed March 21, 2001. The non-final Office action set a one (1) month shortened statutory period of time for reply. The non-final Office action prohibited extensions of time under the provisions of 37 CFR 1.136(a). A reply to the non-final Office action and a petition for extension of time under the provisions of 37 CFR 1.136(a), and alternatively under 37 CFR 1.136(b), was submitted May 21, 2001. Notice of Abandonment was mailed September 20, 2001.

PETITION UNDER 37 CFR 1.137(a)

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(1); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the

filings of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

The present petition lacks requirements (2) and (3) set forth above.

As to item (2), petitioner has failed to establish to the satisfaction of the Director that the entire delay in responding to the non-final Office action until the filing of a grantable petition under 37 CFR 1.137(a) was unavoidable.

The Office may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Commissioner to have been "unavoidable." See, 37 CFR 1.137(a)(3). Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). A petition to revive an application as unavoidably abandoned cannot be granted where petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

Petitioner indicates that the non-final Office action was not docketed by the firm's docketing department as is the usual procedure. Petitioner, however, states that the non-final Office action was docketed in petitioner's personal docket book. Petitioner failed to indicate the non-extendible nature of the Office action in his personal docket book.

A delay resulting from an error on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided the error was the cause of the delay at issue, there was in a place a business routine for performing the clerical function that could reasonably be

relied upon to avoid errors in its performance, and the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care. See, MPEP 711.03(c).

Petitioner has failed to provide any information regarding the docketing procedures in place at petitioner's law firm. Petitioner has also failed to present any evidence regarding the qualifications of the employee(s) charged with docketing. Nor has petitioner provided any details regarding the level of supervision the employee(s) charged with docketing were given. Petitioner has not presented convincing evidence that reliance upon the employee(s) responsible for docketing represented the exercise of due care.

Moreover, it cannot be found that an error on the part of an employee caused the delay at issue as petitioner acknowledges docketing the non-final Office action for response in his personal docket book and was therefore aware of the need to reply. An act or omission on the part of an attorney cannot constitute unavoidable delay. Such action, while perhaps unintentional in nature, does not preclude a finding of unavoidable delay, even if such action performed by petitioner was the result of a good faith error. See, In re Maldaque, 10 USPQ2d 1477, 1478 Comm'r Pat. 1988). Hence, petitioner's failure to note the non-extendible nature of the Office action in petitioner's personal docket book, while perhaps an unintentional error, cannot be deemed to have been unavoidable within the meaning of 37 CFR 1.137(a).

As to item (3), the required 37 CFR 1.137(a) petition fee has not been submitted. Any renewed petition under the provisions of 37 CFR 1.137(a) must be accompanied by the required fee.

Accordingly, the petition under 37 CFR 1.137(a) is hereby **DISMISSED**.

PETITION UNDER 37 CFR 1.137(b)

The statement of unintentional delay presented in instant petition not comply with the current rule. Effective December 1, 1997, 37 CFR 1.137(b)(3) requires a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR

1.137(b) was unintentional" be submitted. However, the statement presented will be accepted and construed as meaning that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." If this is an incorrect interpretation in view of the rules, petitioner is required to provide a statement to that effect.

The petition has been found in compliance with the provisions of 37 CFR 1.137(b) and is accordingly hereby GRANTED.

PETITION UNDER 37 CFR 1.136

Petitioner contends that a response to the non-final Office action was timely submitted along with a petition under 37 CFR 1.136(a) and, alternatively, under 37 CFR 1.136(b) on May 21, 2001. The response submitted May 21, 2001 states that an extension of time pursuant to 37 CFR 1.136(a) should be permitted as the litigation involving the instant reissue application had been concluded thus making a shortened period of time for reply unnecessary.

The non-final Office action set a one (1) month non-extendible shortened statutory period of time for reply. The reply period was shortened due to the outstanding litigation involving the application. The non-final Office action clearly stated that extensions of time under the provisions of 37 CFR 1.136(a) were not available to applicant due to the pending litigation.

It is current Office procedure to permit one (1) month to reply to Office actions in all reissue applications which are being examined during litigation, or after litigation had been stayed, dismissed, etc., to allow for consideration of the reissue by the Office. This one (1) month period may be extended only upon a showing of clear justification pursuant to 37 CFR 1.136(b). The Office action will inform applicant that the provisions of 37 CFR 1.136(a) are not available. Up to three (3) months may be set for reply if the examiner determines such a period is clearly justified. See, MPEP 1442.01.

Petitioner's argument that extensions of time should be permitted as the litigation involving the instant reissue application has been considered but found unconvincing.

The time for responding to Office communications is set for at 35 CFR 133 wherein it states that "[u]pon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable."

As the non-final Office action required reply within one (1) month and did not permit extensions of time pursuant to 37 CFR 1.136(a), the application became abandoned upon failure to receive a response within the one month time period set forth for reply irrespective of the resolution of the litigation. Accordingly, the petition for extension of time under 37 CFR 1.136(a) is DISMISSED.

Petitioner states that alternative to the entry of a petition for extension of time under 37 CFR 1.136(a), the response to the non-final Office action should be considered timely as it was accompanied by a petition for an extension of time under 37 CFR 1.136(b).

The provisions of 37 CFR 1.136(b) state in pertinent part that when a reply cannot be filed within the time period set for such reply and the provisions of 37 CFR 1.136(a) are not available, the period for reply will be extended only for sufficient cause and for a reasonable time specified. More importantly, **any request for an extension of time under 37 CFR 1.136(b) must be filed on or before the day on which such reply is due, but the mere filing of such a request will not affect any extension under this paragraph.**

As the request for extension of time under 37 CFR 1.136(b) must be submitted on or before the due date for reply, the request for an extension of time under 37 CFR 1.136(b) should have been submitted on or prior to April 21, 2001. As the request for extension of time was untimely submitted, the request is accordingly DISMISSED.

As the petition for extension of time has not been entered, petitioner is entitled to a refund of the previously submitted petition for extension of time fee in the amount of \$110.00. Requests for refund should be directed to the Finance Office,

Refund Section. A copy of this decision should accompany any such request.

This application is being forwarded to Technology Center 3700 for further processing.

Telephone inquiries concerning this matter may be directed to Petitions Attorney Alesia M. Brown at (703) 305-0310.

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